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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/992,463	11/14/2001	James H. Ailey	10368/25901	7559

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EXAMINER

STASHICK, ANTHONY D

ART UNIT PAPER NUMBER

3728

DATE MAILED: 12/01/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/992,463

Applicant(s)

AILEY ET AL.

Examiner

Anthony D Stashick

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 1-4 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 27-30 is/are allowed.
- 6) ☒ Claim(s) 5-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### *Election/Restrictions*

1. This application contains claims drawn to an invention nonelected without traverse in the phone call to Charles Catropia on March 31, 2003. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01. Affirmation of this election must be made by applicant in replying to this Office action. Since applicant did not specifically affirm the election, the parenthetical expressions following the claims will be considered an affirmation of the elected species. Claims 1-4 are hereby withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 5, 8-9, 14-15, 18 and 20-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Sewall 2,252,417. Sewall '417 discloses all the limitations of the claims including the following: an insole with a periphery having medial, lateral, forward and rearward edges (see especially, Figures 18 and 19); a base strip 55, 53, 71 with a first portion 71 positioned at the rear foot region of the insole; a second portion 53 of the base strip positioned at the forefoot region of the insole; a toe piece 55 positioned at the toe region of the insole; the second portion 53 of the base strip more flexible than the first portion 71 of the base strip (see page 4, left col. lines 41-56); footwear upper attached to sole to form receiving area (typical for a "shoe"); foot bed positioned above strip portions (see Figures 18 and

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19); insole positioned on the inside surface of the outsole (typical positioning of an insole and the invention in Sewall '417 is an insole); holding members affix insole to sole at shank portion (adhesive).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sewall 2,252,417.

Sewall '417 discloses all the limitations of the claims as noted above. Sewall also discloses, in another embodiments, the desire to skive the ends of portions of the insole that at fasten in line, to prevent the feel of the transition from one portion to the other. Therefore, it would have been obvious to skive all portion of the base strip and insole where the portions come together to prevent the feel of the transition from one portion to the other and to prevent excessive build-up of the insole in the area where the portions come together.

6. Claims 7, 10-13, 16, 17, 18 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sewall 2,252,417 as applied to claims 5, 8, 14 and 25 above in view of Moronaga et al.

4,633,598. Sewall '417 as applied to claims 5, 14 and 25 above disclose all the limitations substantially as claimed except for the third portion positioned in contact with the first portion and shaped with the first portion, a tuck portion underlying the first portion, the foot bed having an intermediate portion and a surface portion with the surface portion being made of textile and the intermediate portion being made of foam material. Moronaga et al. '598 teaches that a tuck portion 4 can be placed underneath the heel or rear portion of an insole and shaped as the rear portion of the insole to aid in the absorbing of shock

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from impact of the user's foot with the ground. Therefore, it would have been obvious to place a third portion, such as the tuck shown in Moronaga et al. '598, under the first portion in the rear foot area of Sewall '417, to aid in absorbing the shock of the user's initial contact with the ground. Furthermore, Moronaga et al. '598 teaches that an insole with a lower layer can have a foot bed including an intermediate portion formed of foamed material (see col. 2, lines 3-9) and a top surface made of soft material such as fabric (textile) to aid in making the insole feel more comfortable to the user. Therefore, it would have been obvious to make the upper layer of the insole of Sewall '417 out of layers of foam and fabric, as taught by Moronaga et al. '598, to aid in giving more comfort and cushioning to the user's foot during use.

#### ***Response to Arguments***

7. Applicant's arguments filed September 10, 2003 have been fully considered but they are not persuasive. Applicant argues that the references to Sewall does not disclose a single uniform thickness layer as that required by the claim language. This argument is not clearly understood. Inasmuch as that which is shown in the instant application in Figure 2, multiple layers of material 63, 64, 65 and 66 are used to form the "single uniform thickness layer". Since the reference to Sewall includes similar structure to that which is shown by applicant to meet the single uniform thickness layer, i.e. more than one layer such as that shown in Figure 2 of the instant application with respect to reference numbers 63 and 64, Sewall is deemed to meet this limitation in the claims.

#### ***Allowable Subject Matter***

8. Claims 27-30 are allowed over the prior art of record.

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### *Conclusion*

9. In any amendment to the disclosure of the instant application, applicant should specifically point out the support for any amendments made to the disclosure (the disclosure includes the written disclosure as well as the claims and drawings). See MPEP § 714.02 and 2163.06.

Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, "should be directed to the group clerical personnel and not to the examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners", M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g., copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers or other general questions should be directed to Tech Center 3700 Customer Service at (703) 306-5648, email [CustomerService3700@uspto.gov](mailto:CustomerService3700@uspto.gov).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony D Stashick whose telephone number is 703-308-3876. The examiner can normally be reached on Monday through Thursday from 6:30 am until 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 703-308-2672. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

Other helpful telephone numbers are listed for applicant's benefit.

Allowed Files & Publication	(703) 305-8322
Assignment Branch	(703) 308-9287
Certificates of Correction	(703) 305-8309
Drawing Corrections/Draftsman	(703) 305-8404/8335
Fee Increase Questions	(703) 305-5125
Intellectual Property Questions	(703) 305-8217
Petitions/Special Programs	(703) 305-9282
Terminal Disclaimers	(703) 305-8408
Informal Fax for 3728	(703) 308-7769

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If the information desired is not provided above, or has been changed, please do not call the examiner (this is the latest information provided to him) but the general information help line below.

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1-800-786-9199  
<http://www.uspto.gov/>



Anthony D Stashick  
Primary Examiner  
Art Unit 3728

ADS  
November 26, 2003